

## **STATUS OF CLAIMS**

Claims 1, 3-15, 55, 56, 58-62, 64-67, 70 and 71 are pending.

Claims 1, 3-15, 55, 56, 58-62, 64-67, 70 and 71 stand rejected.

Claims 3, 5, 7, 15, 55, 56, 58-62, 64-67, 70 and 71 have been cancelled without prejudice herein.

Claims 1, 4, 6 and 11-14 have been amended without prejudice herein.

New Claims 72-75 have been added herein.

## **REMARKS**

### ***Change of Correspondence Address***

Applicant has included herewith a form PTO/SB/122, requesting that all further correspondence be directed to the address associated with PTO Customer Account 45722.

### ***35 U.S.C. 103(a) Rejections***

Claims 1, 3-15, 55-56, 58-62, 64-67 and 70-71 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Leatherman (United States Patent No. 5,544,044) in view of Johnson (United States Patent No. 4,987,538) further in view of Shults (United States Patent No. 6,324,516). Applicant traverses these rejections for at least the following reasons.

#### ***A. Introduction***

As an initial matter, Applicant notes the Final Office action apparently misinterprets Applicant's arguments presented in its prior response of December 2, 2005. Applicant submits it is well established that a *prima facie* case of obviousness under 35 U.S.C. 103(a) requires that the cited prior art references must teach or suggest all the claim limitations. *See, e.g., In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)*. Thus, where the cited references do not teach or suggest all of the claim limitations, a *prima facie* case of obviousness is lacking. Applicant argued in the prior response that since the cited art fails

to teach or suggest each of the limitations of any of the then pending claims, a *prima facie* case of obviousness was thus lacking.

Further, Applicant neither cited nor relied upon many of the decisions the Examiner apparently takes issue with (*see, e.g., page 5, lines 7-15* (“*the Examiner respectfully submits that applicant misinterprets the [sic] some of the case law cited. For example, the Court in *In re Fritch* stated “[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references” (emphasis in original).* Applicant did not cite *In re Fritch* in its prior response, and is unsure how it could have therefore misinterpreted it in its papers.

The above notwithstanding, the following summary sets forth exemplary reference characters and pages and line numbers in the specification where an embodiment of each separately argued claim is illustrated or described. The identification of reference characters and pages and line numbers does not constitute a representation that any claim element is limited to the embodiment illustrated at the reference character or described in the referenced portion of the specification.

## **B. Summary**

Independent Claim 1 recites a system for assisting providers to prepare billings associated with workers’ compensation claims. *See, e.g., specification, page 8, lines 7-10* (“*Fig. 1 illustrates a Workers’ Compensation claim verification system of one embodiment of the invention. A provider computer 40 has access to Workers’ Compensation software which can be stored at the server or at the provider computer. The provider can be a doctor, pharmacy or other medical professional.*”; *see also, specification, page 8, lines 23-24* (“*In a preferred embodiment, a number of different providers (not shown) are connected to the Workers’ Compensation claim verification system 44*”); *see also, page 10, lines 1-6* (“*the Workers’ Compensation software includes medical report and billing software which ... inserts the claim number, once obtained, into reports and bills to be sent out.*”); *see also, Fig. 1*. The provider computer software prompts providers to input data concerning workers’ compensation claims. *See, e.g., specification, page 8, lines 16-21* (“*The Workers’ Compensation software prompts the provider to input data sufficient to identify the Workers’ Compensation claim. This data*

*includes name, social security number, and injury date... Additional data such as employer number and insurer name can also be provided.*”). The provider computer software also sends electronic claim number requests containing at least some of the inputted data across the Internet to the workers' compensation claim verification system. *See, e.g., specification, page 8, lines 11-12 (“The provider computer is operably connected with the Workers’ Compensation verification system 44.”); see also, specification, page 12, lines 16-18 (“In step 50, the provider, using the software program, sends an electronic inquiry request across the Internet to the Workers’ Compensation claims verification system.”); see also, Fig. 2.*

Responsively thereto, the Workers’ Compensation claims verification system receives the sent data; and determines whether matching workers' compensation claim numbers associated with the received data exist. *See, e.g., specification, page 12, lines 18-19 (“In step 52, it is determined whether the inquiry refers to a claim number in the Workers Compensation claim verification system’s database.”); see also, Fig. 2.* The Workers’ Compensation claim verification system electronically supplies the matching workers' compensation claim numbers determined to exist to corresponding ones of the sending provider computers, wherein said providers use said supplied claim numbers to prepare the billings. *See, e.g., specification, page 12, lines 19-21 (“If so, in step 54, the claim verification system automatically sends an indication of the Workers’ Compensation claim number to the provider.”); see also, page 10, lines 1-6 (“the Workers’ Compensation software includes medical report and billing software which ... inserts the claim number, once obtained, into reports and bills to be sent out.”); see also, Fig. 2.* And, the Workers’ Compensation claim verification system automatically sends an indication of the lack of determining the workers' compensation claim number to at least one of a plurality of payer computers, each being associated with a different payer, for each matching workers’ compensation claim number determined not to exist. *See, e.g., specification, page 12, lines 23-26 (“In step 56, if the database does not contain the claim number, the claim verification system automatically sends an early alert message to the payer. In step 58, the payer prompts an employer to provide a claim incident report, submission of which allows a payer to assign a Workers’ Compensation claim number.”); see also, specification, page 9, lines 13-17 (“The Workers’ Compensation claim verification system 44 is also not payer system dependent. Multiple payers’ data can be stored in the Workers’ Compensation claim verification system 44.*

*The provider need only interface with the Workers' Compensation claim verification system 44 rather than interfacing with a variety of payer computers.''); see also, Fig. 2.*

Present Claim 1 thus broadly encompasses: (1) software accessed at a provider computer (1a) prompting a provider for Workers' Compensation claim data, and (1b) sending at least part of that data to a verification system; and (2) a verification system (2a) determining whether a matching claim number exists for the sent data, and (2b) if a matching claim number does exist, sending it to the corresponding provider computer, where it is used in preparing billings and (2c) if a matching claim number does not exist, sending an indication thereof to payer computer(s). All of the remaining claims depend from independent Claim 1.

***C. Leatherman, Johnson and Shults fail, in any combination, to teach or suggest each of the limitations of Claim 1.***

Leatherman, Johnson and Shults fail, in any combination, to teach or suggest a system including: (1) software accessed at a provider computer (1a) prompting a provider for Workers' Compensation claim data, and (1b) sending at least part of that data to a verification system; and (2) a verification system (2a) determining whether a matching claim number exists for the sent data, and (2b) if one does exist, sending it to a corresponding provider computer where it is used in preparing billings, and (2c) if one doesn't exist sending an indication thereof to payer computer(s), each associated with a different payer.

***1. Leatherman, Johnson and Shults fail to teach or suggest a system for assisting providers to prepare billings associated with workers' compensation claims.***

Claim 1 recites, in part:

A system for assisting providers to prepare billings associated with workers' compensation claims, comprising: ...  
a workers' compensation claims verification system ...  
[that] electronically supplies the matching workers' compensation  
claim numbers determined to exist to corresponding ones of the  
sending provider computers, wherein said providers use said  
supplied claim numbers to prepare the billings.

The portions of Leatherman cited in the Office action relate solely to a general purpose computer. Johnson teaches a payer computer that processes previously prepared provider billings. *See, e.g., Title; see also, col. 1, line 66 – col. 2, line 15.* Likewise, the Shults reference processes UR agreements in accordance with previously prepared provider bills. *See, e.g., Abstract, lines 10-22.* Accordingly, Leatherman, Johnson and Shults fail, in any combination, to teach or suggest: “A system for assisting providers to prepare billings associated with workers’ compensation claims, comprising: ... a workers’ compensation claims verification system ... [that] electronically supplies the matching workers' compensation claim numbers determined to exist to corresponding ones of the sending provider computers, wherein said providers use said supplied claim numbers to prepare the billings”, as is recited by Claim 1. For at least this reason, reconsideration and withdrawal of this 35 USC 103 rejection is requested.

**2. *Leatherman, Johnson and Shults fail to teach or suggest a verification system and a plurality of provider computers.***

Claim 1 recites, in part:

A system for assisting providers to prepare billings associated with workers’ compensation claims, comprising:  
a workers’ compensation claims verification system; [and]  
software accessed at a plurality of provider computers, the software prompting providers to input data concerning workers' compensation claims, and sending electronic claim number requests containing at least some of the inputted data across the Internet to the workers' compensation claim verification system.

Leatherman, Johnson and Shults also fail, in any combination, to teach or suggest these limitations.

The Final Office action argues, by incorporating the August 2, 2005 reasons for rejection, that Leatherman teaches a provider computer, and:

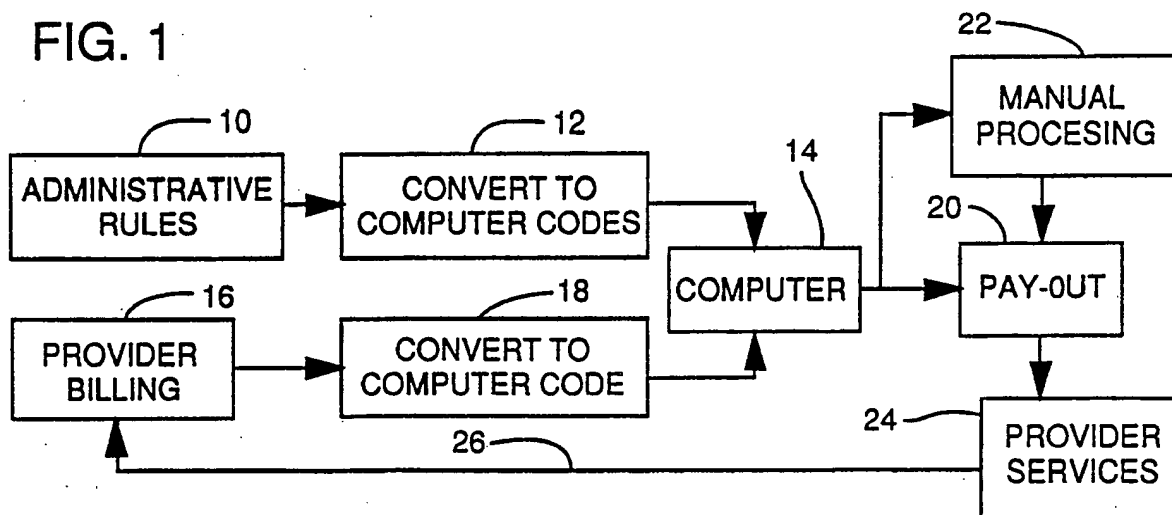
Johnson suggests the software adapted to prompt the provider to input data concerning a workers' compensation claim, the software adapted to send an electronic claim number request containing at least some of the data across the Internet to a workers' compensation claim verification system (See Johnson, Col.2, lines 1-67 to Col.3, line 49); and a workers' compensation claims verification system adapted to receive the at least some of the data and to determine therefrom any matching workers' compensation

claim number, if there is a matching workers' compensation claim number, the workers' compensation claims verification system is adapted to electronically supply the matching workers' compensation claim number to the provider computer, if there is no matching workers' compensation claim number (See Johnson, Col.2, lines 1-67 to Col.3, line 49).

Applicant traverses these assertions.

The cited portions of Leatherman merely provide general teachings regarding a computer. The Johnson reference fails to teach or suggest software accessed at a computer and a separate workers' compensation claims verification system – and clearly fails to teach software accessed at a plurality of provider computers and a separate workers' compensation claims verification system as recited by Claim 1.

To further clarify the distinction, Fig. 1 of Johnson (reproduced herein-below) shows a flow diagram illustrating its process steps. *See, e.g., Col. 2, lines 36-39.* Therein, provider billings are input at block 16. *See, e.g., col. 3, lines 14-16.* With regard to the provider billings, Johnson teaches that the information from the provider billing must be extracted from insurance billing forms prepared by the provider and input to the computer 14. *See, e.g., col. 2, lines 16-18; col.3, lines 14-18.* Johnson goes on to further explain that inputting the provider billing involves operator data entry. *See, e.g., col. 5, lines 51-62.*



*Fig. 1 of Johnson*

Thus, Johnson teaches a single computer 14 that processes provider bills for a payer – and thus fails to teach or suggest the recited software accessed at a plurality of provider computers and a separate workers' compensation claims verification system as recited by Claim 1. Applicant notes Shults is not relied upon in the Final Office action with regard to these Claim 1 limitations, and hence adds nothing to the combined teachings of Leatherman and Johnson in these regards.

Accordingly, the cited art as applied in the Final Office action fails to teach or suggest at least the recited software accessible at a plurality of provider computers and a separate verification system of Claim 1 – as the relied upon portion of Leatherman merely teaches a general purpose computer not even taught to be useful for providers; Johnson merely teaches a single computer at a payer that has provider billing data keyed into it; and Shults is not relied upon in these regards. For this additional reason, reconsideration and withdrawal of this 35 USC 103 rejection is requested.

**3. *Leatherman, Johnson and Shults fail to teach or suggest a verification system that supplies matching claim numbers to providers and indicates missing claim numbers to payers.***

Claim 1 recites, in part:

A system for assisting providers to prepare billings associated with workers' compensation claims, comprising:  
a workers' compensation claims verification system [that]

...

receives the data contained in the electronic claim number requests; and

determines whether matching workers' compensation claim numbers associated with the received data exist;

electronically supplies the matching workers' compensation claim numbers determined to exist to corresponding ones of the sending provider computers, wherein said providers use said supplied claim numbers to prepare the billings, and automatically sends an indication of the lack of determining the workers' compensation claim number to at least one of a plurality of payer computers, each being associated with a different payer, for each matching workers' compensation claim number determined not to exist.

Thus, Claim 1 recites a workers' compensation verification system that both: (1) electronically supplies the matching workers' compensation claim numbers to corresponding ones of the sending provider computers for matching workers' compensation claim numbers determined to exist, and (2) automatically sends an indication of the lack of determining the workers' compensation claim number to at least one of a plurality of payer computers, each being associated with a different payer, for each matching workers' compensation claim number determined not to exist.

As previously discussed, Leatherman is relied upon merely for its general teachings regarding a computer, and Johnson fails to teach or suggest any verification system electronic interaction with any provider computers, no less the recited receiving and sending features of present Claim 1. Furthermore, Johnson does not teach or suggest a verification system electronically interacting with any separate provider computer, and clearly not corresponding ones of a plurality of provider computers, as recited by Claim 1.

In contradistinction, Johnson teaches a process that is practiced between claim approval and claim payout by an insurance company. *See, col. 4, lines 26-31*. The process includes (a) a rules conversion step wherein administrative rules are converted into "computable" terms; (b) a program generating step which inputs codes and processes that enable computer processing; (c) a provider billing input step which identifies a specific provider treatment for processing under the rules; (d) a rules identification step whereby the computer program determines which rules are applicable; and (e) a computing step which determines the maximum allowable pay out. *See, col. 4, lines 26-41*. None of these steps sends any information to a provider computer; and hence clearly fails to send determined claim numbers to corresponding ones of the data sending provider computers for matching workers' compensation claim numbers determined to exist, wherein the providers use the supplied claim numbers to prepare billings -- as is recited by Claim 1.

Thus, contrary to the assertions of the Final Office action, Johnson fails to teach or suggest, "a workers' compensation claims verification system [that] ... electronically supplies the matching workers' compensation claim numbers determined to exist to corresponding ones of the sending provider computers, wherein said providers use said supplied claim numbers to prepare the billings", as is recited by Claim 1.



Further, the Final Office action acknowledges that Leatherman and Johnson fail to teach automatically sending an indication of the lack of determining the workers' compensation claim number to at least one of a plurality of payer computers, each being associated with a different payer, for each matching claim number determined not to exist – as is recited by Claim 1. The Shults reference fails to remedy the shortcomings of Leatherman and Johnson. Shults, like Johnson, teaches a computer system being operable by an insurance company (i.e., a payer), and not a verification system that interacts with a plurality of payer computers, each being associated with a different payer. *See, e.g., Abstract, lines 10-22.*

In other words, Shults like Johnson, teaches processing claims sent from providers to payers, and not processing of provider entered data using a verification system, separate from provider and payer computers, to verify that a claim number exists, and notify at least one of a plurality of payer computers each associated with a different payer, where it is found not to exist – as is recited by Claim 1.

Further yet, the Final Office action cites the iterative procedure code matching process discussed in columns 14 and 15 of Shults. This reliance is without merit. First, these teachings deal with procedure codes and not workers' compensation claim codes. Second, Shults discloses that where no match is found, it merely sets an internal match code to 0 – and, hence fails to teach sending any indication thereof to another computer at all, no less to at least one of a plurality of payer computers each being associated with a different payer, as is recited by Claim 1. *See, col. 15, lines 27-34.*

Accordingly, no combination of Leatherman, Johnson and Shults teaches, or suggests, each of the features and limitations recited in present Claim 1. In view of the foregoing, Applicant respectfully requests reconsideration and removal of this 35 USC 103 rejection of Claim 1. Applicant also requests reconsideration and removal of the rejections of Claims 4, 6, 8-14 and 72-75 as well, at least by virtue of these claims' ultimate dependence from a patentably distinct base Claim 1.

**D. A Proper Motivation For Combining Leatherman, Johnson and Shults to Reach the System Of Claim 1 Is Lacking.**

A *prima facie* case of obviousness can be rebutted where the cited art teaches away from the claimed invention in any material respect. See, *In re Haruna*, 249 F.3d 1327, 58USPQ2d 1517 (Fed. Cir. 2001). A reference teaches away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that was taken by the applicant. *In re Haruna*, 249 F.3d 1327, 58USPQ2d 1517.

The recited verification system of Claim 1 interacts with software being accessible at a plurality of provider computers and a plurality of payer computers. The system of Claim 1 recites processing for claims that have not yet been accepted, in at least that Claim 1 expressly recites, automatically sending an indication of the lack of determining the workers' compensation claim number to at least one of a plurality of payer computers, each being associated with a different payer, for each matching workers' compensation claim number determined not to exist.

Leatherman merely teaches a general purpose computer. Johnson is directed to avoiding overpaying provider billings actually submitted to an insurance company. See, e.g., col. 1, line 65 – col. 2, line 1. Consistently, Johnson teaches “[a]n important first step that occurs is the qualification of the claimant. That is, the claimant is required to have an accepted claim for Workers’ Compensation.” Col. 2, lines 45-47 (*emphasis added*). Johnson goes on to explain that “[c]laim forms are filled out and submitted to the insurance company. If the claim is accepted, the status of acceptance and the assigned claim identification is input to the computer.” Col. 2, lines 49-52. Finally, Johnson teaches that provider billings are qualified on the basis of the claim identification information and enables the computer to charge the billing against an approved claim. Col. 2, lines 52-55.

Shults similarly teaches a payer system processing received bills and requires that a claim number be available. See, e.g., abstract (“Each UR agreement comprises a claim number, a procedure code describing the particular medical service authorized, and some indication as to dates or quantity of service authorized. All of the UR agreements are stored in a UR database. When a medical bill is received by the insurance company, the bill is entered in to the computer. The cost containment system searches all UR agreements in the UR database which have the same claim number as the claim number on the bill. For each item in the medical bill, the system finds the UR agreement which most closely matches the procedure code

*in the line item and various other criteria, such as the dates of treatment. The system then checks to ensure that the item in the bill is authorized by the UR agreement. If the item is authorized, then payment is made. If the item is not authorized, then the item is flagged for further review.”).*

Each of Leatherman, Johnson and Shults must be considered in its entirety, *i.e.*, as a whole, including portions that lead away from the claimed invention. *See, W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Thus, each of Johnson and Shults expressly teaches that a claim number is required to be available to process claims. Accordingly, it is improper to discount these teachings of Johnson and Shults, and modify the systems of Leatherman, Johnson and Shults to reach the claimed invention, that automatically sends an indication of the lack of determining the workers’ compensation claim number to at least one of a plurality of payer computers, each being associated with a different payer, for each matching claim number determined not to exist absent impermissible hindsight gleaned from Applicant’s own disclosure.

In view of the foregoing, Applicant respectfully submits a proper motivation for combining the cited references in an attempt to reach the features and limitations of present Claim 1 is lacking, as both Johnson and Shults would lead a skilled artisan in a direction divergent from the path that was taken, and is claimed by the Applicant. For this additional reason, reconsideration and withdrawal of this 35 USC 103 rejection is requested.

***E. New Claims 72-75***

Newly added dependent claim 72 recites, “[t]he system of Claim 1, wherein each payer is a different insurer.” Support for Claim 72 may be found, by way of example only, in the specification, at page 1, lines 11-15. New Claims 73 and 74 recite, “[t]he system of Claim 72, wherein each sent indication alerts the associated insurer of a potential lack of claim incident information”, and “[t]he system of Claim 72, wherein each indication prompts the associated insurer to request claim incident information from an insured”, respectively. Support for Claims 73 and 74 may be found, by way of further example, in the specification at page 12, lines 23-26

("In step 56, if the database does not contain the claim number, the claim verification system automatically sends an early alert message to the payer. In step 58, the payer prompts an employer to provide a claim incident report, submission of which allows a payer to assign a Workers' Compensation claim number."). New Claim 75 recites, "[t]he system of Claim 74, wherein each provider is a doctor having an associated patient having an associated employer, wherein the employer is the insured." Support for Claim 75 may be found, by way of further example, in the specification at page 1, line 11 – page 2, line 12. Accordingly, no new matter has been added by these claim amendments.

### **CONCLUSION**

Applicant believes he has addressed all outstanding grounds raised in the outstanding Office action, and respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited.

Should there be any questions or outstanding matters, the Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Edward J. Howard', written over a horizontal line.

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Dated: June 28, 2006

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